



DAE  
JFW

UV-33 Cont.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicants : Edward B. Knudson et al.  
Application No. : 09/418,461 Confirmation No. : 8923  
Filed : October 15, 1999  
For : INTERACTIVE TELEVISION PROGRAM GUIDE  
SYSTEM WITH PAY PROGRAM PACKAGE  
PROMOTION  
Art Unit : 2611  
Examiner : Christopher R. Nalevanko

Mail Stop Petition New York, New York 10020  
Commissioner for Patents July 25, 2005  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

PETITION UNDER 37 C.F.R. § 1.181  
TO WITHDRAW HOLDING OF ABANDONMENT  
BASED ON FAILURE TO REPLY WITHIN TIME PERIOD  
OR IN THE ALTERNATIVE PETITION TO REVIVE AN  
ABANDONED APPLICATION UNDER 37 C.F.R. § 1.137

Applicants hereby petition under 37

C.F.R. § 1.181 to withdraw the holding of Abandonment set forth in the Notice of Abandonment mailed on June 1, 2005 (copy attached at Exhibit A) or in the alternative applicants hereby petition under 37 C.F.R. § 1.137 to revive the abandoned application.

In accordance with 37 C.F.R. § 1.181, applicants make this Petition within two months of the mailing date of the Notice of Abandonment.

### Statement of Facts

On July 8, 2004, an Office Action was mailed by the United States Patent and Trademark Office ("USPTO"). On October 7, 2004, applicants filed a Reply to the Office Action (unexecuted copy attached at Exhibit B), a Transmittal Letter (unexecuted copy attached at Exhibit C), and a Terminal Disclaimer Under 37 C.F.R. § 1.321(b, c) (unexecuted copy attached at Exhibit D).

The Reply to the Office Action (see Exhibit B), the Transmittal Letter (see Exhibit C), and the Terminal Disclaimer (see Exhibit D) contain a minor error in the identification of the application. The application number listed on the front of these papers contains two transposed digits and lists the application number as "09/418,461" instead of "09/418,416". The papers did correctly list the Art Unit, the Filing Date, the Examiner Name, the Title, the Confirmation Number, and the Attorney Docket Number. The papers could have been identified correctly based on this information or could have been returned to the applicants for correction (See MPEP § 502).

The enclosed copies of the return postcard, date stamped as received by the USPTO on October 7, 2004 (copy attached at Exhibit E), the Express Mail Certification

(unexecuted copy attached at Exhibit F), and the Express Mail Label, date stamped October 7, 2004 by the United States Post Office (copy attached at Exhibit G) demonstrate that the Reply was timely filed. (See 37 C.F.R. § 1.10 and MPEP §§ 503 and 711.03(c)(I)(B)).\*

The enclosed copies of the Reply to Office Action (see Exhibit B), the Transmittal Letter (see Exhibit C), the Terminal Disclaimer (see Exhibit D), and the Express Mail Certification (see Exhibit F) are all unexecuted. Applicants cannot currently locate copies of the executed documents. Instead applicants have re-printed, from electronic files, documents that applicants believe are identical to the originally transmitted documents. Applicants also enclose herewith newly executed and corrected versions of a Reply to the Office Action and a Terminal Disclaimer (attached at exhibit H).\*\*

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\* The return postcard (see Exhibit E) was printed with the incorrect application number ("09/418,416"). The incorrect application number was later corrected by pen to recite to the correct application number ("09/418,461"). Applicants do not know whether this correction was made before the filing of the Reply or after the receipt of the return postcard. In any event, the return postcard correctly identifies the above-referenced application by applicant, filing date, confirmation number, attorney docket number (UV-33 Cont), attorney matter number (003597.0033), and the express mail number. The Express mail label (see Exhibit G) corresponding to the express mail number listed on the return postcard also lists the attorney matter number (003597.0033) corresponding to this case.

\*\* Applicants have corrected the newly executed versions of the Reply to Office Action and the Terminal Disclaimer with the correct application number. Applicants have also corrected the newly executed Terminal Disclaimer to correct minor clerical errors in the listings of the frame numbers at which a few of the referenced assignment documents were recorded.

On June 1, 2005, the Notice of Abandonment (see Exhibit A) was mailed by the USPTO stating that this application was abandoned because the Reply to the July 8, 2004 Office Action was not received. Applicants respectfully submit that the Notice of Abandonment was issued in error. Applicants respectfully request that the holding of abandonment be withdrawn because the Reply was originally filed by Express Mail on October 7, 2004 as evidenced by the stamped Express Mail Label and the stamped return postcard (see Exhibits E and G).

Applicants respectfully request that the Reply and the Terminal Disclaimer be entered in the above-identified patent application, and that prosecution of the application resume its normal course.

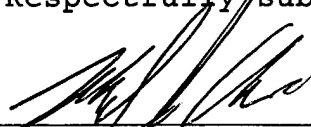
With the Reply applicants supplied a check in the amount of \$110.00 for the Terminal Disclaimer. This check was cashed by the Patent Office on October 14, 2004 (copy attached at Exhibit I). Accordingly, applicants believe that no further fees should be due in connection with this Terminal Disclaimer.

Applicants believe that no fees are due in connection with this Petition. However, the Director is hereby authorized to charge payment of any fees that may be required in connection with the paper(s) transmitted

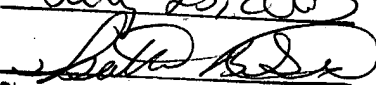
herewith, or to credit any overpayment of same, to Deposit  
Account No. 06-1075, Order No. 003597-0033. A duplicate  
copy of this paper is enclosed herewith.

In the alternative, if the Patent and Trademark  
Office deems that this Petition to Withdraw Holding of  
Abandonment Based on Failure to Reply Within Time Period  
should be considered a Petition to Revive an Abandoned  
Application under 37 C.F.R. § 1.137, applicants submit that  
in view of the above-recited statement of facts the entire  
delay in filing the required reply until the filing of a  
grantable petition pursuant to 37 C.F.R. § 1.137(b) was  
unintentional. The Director is hereby authorized to charge  
payment of the appropriate petition fee set forth in 37  
C.F.R. § 1.17(m), and any additional fees, to Deposit  
Account No. 06-1075, Order No. 003597-0033. A duplicate  
copy of this paper is enclosed.

Respectfully submitted,

  
\_\_\_\_\_  
Michael J. Chasan  
Reg. No. 54,026  
Agent for Applicants  
FISH & NEAVE IP GROUP  
ROPES & GRAY LLP  
Customer No. 1473  
1251 Avenue of the Americas  
New York, New York 10020-1104  
Tel: (212) 596-9000  
Fax: (212) 596-9090

I hereby certify that this  
Correspondence is being  
deposited with the U.S.  
Postal Service as First  
Class Mail in an envelope  
Addressed to:  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450 on

*July 28, 2005*  
  
\_\_\_\_\_  
Signature of Person Signing



## UNITED STATES PATENT AND TRADEMARK OFFICE

M. CHASAN

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/418,461	10/15/1999	EDWARD B. KNUDSON	UV-33-CONT	8923

7590

06/01/2005

G VICTOR TREYZ  
FISH & NEAVE  
1251 AVENUE OF THE AMERICAS  
NEW YORK, NY 100201104

**RECEIVED**

JUN 06 2005

ROPES & GRAY LLP - PATENT DEPT.  
REFERRED TO SMG/MJC  
NOTED BY \_\_\_\_\_

DATE MAILED: 06/01/2005

EXAMINER	
NALEVANKO, CHRISTOPHER R	
ART UNIT	PAPER NUMBER
2611	

**REMINDER - PLEASE INITIAL  
THIS DOCUMENT TO INDICATE  
THAT YOU HAVE SEEN IT**

Please find below and/or attached an Office communication concerning this application or proceeding.

DOCKETEL FOR  
Abandon?

8/1/05

**Notice of Abandonment**

Application No.

09/418,461

Examiner

Christopher R. Nalevanko

Applicant(s)

KNUDSON ET AL.

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 08 July 2004.

- (a) ☐ A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
- (b) ☐ A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.  
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
- (c) ☐ A reply was received on \_\_\_\_\_ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
- (d) ☒ No reply has been received.

2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).

- (a) ☐ The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
- (b) ☐ The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
- (c) ☐ The issue fee and publication fee, if applicable, has not been received.

3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).

- (a) ☐ Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
- (b) ☐ No corrected drawings have been received.

4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.

5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.

6. ☐ The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.

7. ☐ The reason(s) below:

CHRIS GRANT  
PRIMARY EXAMINER

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.



UV-33 Cont.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicants : Edward B. Knudson et al.  
Application No. : 09/418,416 Confirmation No. : 8923  
Filed : October 15, 1999  
For : INTERACTIVE TELEVISION PROGRAM GUIDE SYSTEM  
WITH PAY PROGRAM PACKAGE PROMOTION  
Group Art Unit : 2611  
Examiner : Christopher R. Nalevanko

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

REPLY TO OFFICE ACTION

Sir:

Responsive to the July 8, 2004 Office Action,  
applicants respectfully request reconsideration and allowance of  
this application in light of the following remarks.



## REMARKS

### I. Introduction

Claims 1-64 are pending in this application.

Claims 1-14, 16, 18-31, 33, 35-46, 48, 50-61, and 63 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,016,141.

Claims 15, 17, 32, 34, 47, 49, 62, and 64 are objected to as being dependent upon a rejected based claim.

The Examiner's rejections should be withdrawn in view of the following remarks.

### II. The Double Patenting Rejection

Claims 1-14, 16, 18-31, 33, 35-46, 48, 50-61, and 63 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,016,141.

Applicants are submitting herewith a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) to obviate the double patenting rejection. A check in the amount of \$110.00 in payment of the disclaimer fee set forth in 37 C.F.R.

§ 1.20(d) is enclosed. The double patenting rejection should therefore be withdrawn.

Claims 15, 17, 32, 34, 47, 49, 62, and 64 depend from claims 1, 18, 35, and 50 and are objected to as being dependent upon a rejected based claim. The objections to these claims should also be withdrawn in view of the above-mentioned Terminal Disclaimer.

### III. Conclusion

The foregoing demonstrates that claims 1-64 are patentable. This application is therefore in condition for allowance. Reconsideration and allowance are accordingly respectfully requested.

Respectfully submitted,

---

Cathy Ding  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Edward B. Knudson et al.  
Application No.: 09/418,416 Confirmation No.: 8923  
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Group Art Unit : 2611  
Examiner : Christopher R. Nalevanko

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, V.A. 22313-1450

TRANSMITTAL LETTER

Sir:

Transmitted herewith: [ ] a Preliminary Amendment;  
[X] Reply To Office Action to be filed in the above-  
identified patent application.

FEE FOR ADDITIONAL CLAIMS

[X] A fee for additional claims is not required.  
[ ] A fee for additional claims is required.

The additional fee has been calculated as shown below:

ADD'L FEES	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE
TOTAL CLAIMS	-	64	=	X \$18 = \$

INDEPENDENT CLAIMS	-	4	=	X \$88 = \$
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FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM				+ \$300 = \$
* If less than 20, insert 20.				
** If less than 3, insert 3.			TOTAL	\$

- ☐ A check in the amount of \$\_\_\_\_\_ in payment of the filing fee is transmitted herewith.
- ☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 C.F.R. § 1.16, in connection with the paper(s) transmitted herewith, or credit any overpayment of same, to deposit Account No. 06-1075. A duplicate copy of this transmittal letter is transmitted herewith.
- ☐ Please charge \$\_\_ to Deposit Account No. 06-1075 in payment of the filing fee. A duplicate copy of this transmittal letter is transmitted herewith.

EXTENSION FEE

- ☐ The following extension fee is applicable to the Response filed herewith: ☐ \$110.00 extension fee for response within first month pursuant to 37 C.F.R. § 1.136(a); ☐ \$420.00 extension fee for response within second month pursuant to 37 C.F.R. § 1.136(a); ☐ \$950.00 extension fee for response within third month pursuant to 37 C.F.R. § 1.136(a); ☐ \$1,480.00 extension fee for response within fourth month pursuant to 37 C.F.R. § 1.136(a); ☐ \$2,010.00 extension fee for response within fifth month pursuant to 37 C.F.R. § 1.136(a)
- ☐ A check in the amount of ☐ \$110.00; ☒ \$420.00; ☐ \$950.00; ☐ \$1,480.00; ☐ \$2,010.00; in payment of the extension fee is transmitted herewith.
- ☒ The Director is hereby authorized to charge payment of any additional fees required under 37 C.F.R. § 1.17 in connection with the paper(s) transmitted herewith, or to credit any overpayment of same, to Deposit Account No. 06-1075. A duplicate copy of this transmittal letter is transmitted herewith.

[ ] Please charge the [ ] \$110.00; [ ] \$420.00;  
[ ] \$950.00; [ ] \$1,480.00; [ ] \$2,010.00;  
extension fee to Deposit Account No. 06-1075. A  
duplicate copy of this transmittal letter is  
transmitted herewith.

---

Cathy Ding  
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Tel.: (212) 596-9000



UV-33 Cont.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicants : Edward B. Knudson et al.  
Application No. : 09/418,416 Confirmation No. : 8923  
Filed : October 15, 1999  
For : INTERACTIVE TELEVISION PROGRAM GUIDE SYSTEM  
WITH PAY PROGRAM PACKAGE PROMOTION  
Group Art Unit : 2611  
Examiner : Christopher R. Nalevanko

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

TERMINAL DISCLAIMER UNDER 37 C.F.R. § 1.321(b, c)

Sir:

United Video Properties, Inc., a corporation of the State of Delaware, having its principal office and place of business at 7140 South Lewis Avenue, Tulsa, Oklahoma 74136, represents that it is the assignee of the entire, right, title and interest in and to the following issued United States Patent and pending United States Patent Application:

1. Knudson et al. United States Patent  
No. 6,016,141, for an "INTERACTIVE TELEVISION PROGRAM GUIDE  
SYSTEM WITH PAY PROGRAM PACKAGE PROMOTION," issued January 18,

2000 (the '141 patent). An assignment from the named inventors to TCI-TVGOS, INC. and NEWS AMERICA PUBLICATIONS INC. that is effective for the '141 patent was recorded on September 17, 1998 at Reel 9455, Frames 0195-0212. A Certificate of Amendment of Certificate of Incorporation of NEWS AMERICA PUBLICATIONS INC. that changes the name of NEWS AMERICA PUBLICATIONS INC. to TV Guide Magazine Group, Inc. was filed in the Office of the Secretary of State of the State of Delaware on February 25, 1999 and recorded on July 1, 1999 at Reel 010064, Frames 0925-0927. A confirmatory assignment for the '141 patent from TV Guide Magazine Group, Inc. to TV GUIDE, INC. was executed on June 11, 1999 and recorded on July 1, 1999 at Reel 010064, Frames 0878-0881. A confirmatory assignment for the '141 patent from TCI-TVGOS, INC. to United Video Properties, Inc. was executed on June 16, 1999 and recorded on July 1, 1999 at Reel 010064, Frames 0694-0687. A confirmatory assignment for the '141 patent from TV GUIDE, INC. to United Video Properties, Inc. was executed on June 11, 1999 and recorded on July 1, 1999 at Reel 010064, Frames 0822-08245.

2. Knudson et al. United States Patent Application No. 09/418,461, for an "INTERACTIVE TELEVISION PROGRAM GUIDE SYSTEM WITH PAY PROGRAM PACKAGE PROMOTION," filed October 15, 1999 (the '461 application). An assignment from the named inventors to TCI-TVGOS, INC. and NEWS AMERICA PUBLICATIONS INC. that is effective for the '461 application was recorded on September 17, 1998 at Reel 9455, Frames 0195-0212. A Certificate of Amendment of Certificate of Incorporation of NEWS AMERICA PUBLICATIONS INC. that changes the name of NEWS AMERICA PUBLICATIONS INC. to TV Guide Magazine Group, Inc. was filed in

the Office of the Secretary of State of the State of Delaware on February 25, 1999 and recorded on July 1, 1999 at Reel 010064, Frames 0925-0927. A confirmatory assignment for the '461 application from TV Guide Magazine Group, Inc. to TV GUIDE, INC. was executed on June 11, 1999 and recorded on July 1, 1999 at Reel 010064, Frames 0878-0881. A confirmatory assignment for the '461 application from TCI-TVGOS, INC. to United Video Properties, Inc. was executed on June 16, 1999 and recorded on July 1, 1999 at Reel 010064, Frames 0694-0687. A confirmatory assignment for the '461 application from TV GUIDE, INC. to United Video Properties, Inc. was executed on June 11, 1999 and recorded on July 1, 1999 at Reel 010064, Frames 0822-08245.

The undersigned, on behalf of United Video Properties, Inc., hereby disclaims the terminal portion of the term of any patent to be issued on the '461 application, which would extend beyond the expiration date of the full statutory term of the '141 patent.

The undersigned, on behalf of United Video Properties, Inc., agrees that any patent to be issued on the '461 application shall be enforceable only for and during such period as the legal title to such patent shall be the same as the legal title to the '141 patent, this agreement to run with any patent to be issued on the '461 application and to be binding upon the grantee of such patent and its successors and assigns.

The undersigned, on behalf of United Video Properties, Inc., does not disclaim any terminal part of the term of any patent to be issued on the '461 application, prior to the expiration date of the full statutory term of the '141 patent, in the event that the '141 patent: (a) expires for failure to



pay a maintenance fee, (b) is held unenforceable, (c) is found invalid, (d) is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321(a, b), (e) has all claims canceled by a reexamination certificate, or (f) is otherwise terminated prior to expiration of its statutory term, except for the separation of legal title stated above.

The undersigned hereby states and certifies that:

1. He is an officer of assignee corporation United Video Properties, Inc. and is authorized to act on behalf of assignee corporation in connection with said application; and

2. The relevant evidentiary documents have been reviewed and, to the best of the undersigned's and assignee's knowledge and belief, title to the '461 application is in assignee.

UNITED VIDEO PROPERTIES, INC.

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Samir Armaly  
Vice President Of Intellectual  
Property and Licensing

DOCKET NO.  
CONFIRMATION NO.

UV-33 Cont.  
8923

APPLICANT Edward B. Knudson et al.

APPLICATION NO. 09/418,464 FILED October 15, 1999

RECEIPT IS HEREBY ACKNOWLEDGED OF THE  
Transmittal Letter (in duplicate); Reply to Office Action; Terminal Disclaimer Under 37  
C.F.R. § 1.321.(b, c); check in the amount of \$110.00 for Terminal Disclaimer; and return  
postcard

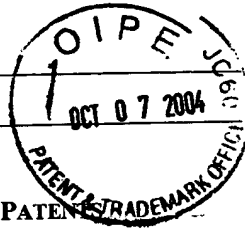
DATED October 7, 2004

FILED IN CONNECTION WITH THE ABOVE CASE.

COMMISSIONER FOR PATENT

CD: 003597.0033

EXPRESS MAIL NO.  
EV270265115US





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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Edward B. Knudson et al.  
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Group Art Unit : 2611  
Examiner : Christopher R. Nalevanko

"Express Mail" mailing label number: EV270265115US.  
Date of Deposit: October 7, 2004.

I hereby certify that this paper/fee is being deposited with the United States Postal Service "EXPRESS MAIL POST OFFICE TO ADDRESSEE" service under 37 C.F.R. § 1.10 on the date indicated above and is addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Encls.:

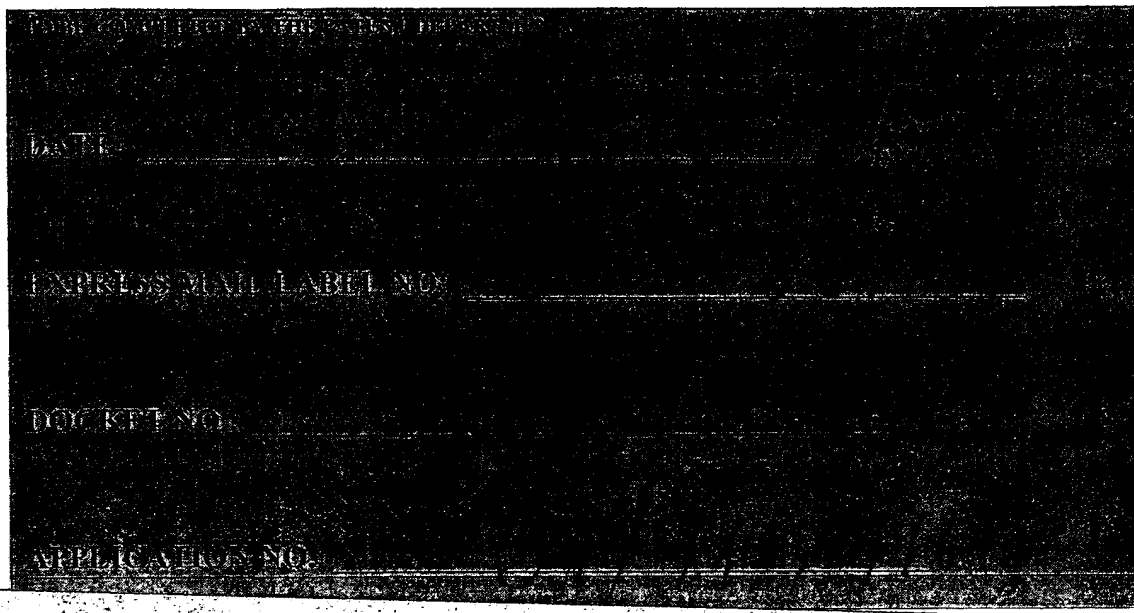
- (1) Transmittal Letter (in duplicate);
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- (3) Terminal Disclaimer Under 37 C.F.R. § 1.321(b, c);
- (4) Check in the amount of \$110.00 for Terminal Disclaimer; and
- (5) Postcard.

PACKAGE TO BE HAND-CARRIED TO P.O.

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METHOD OF PAYMENT Express Mail Corporate Acct. No.		Total Postage & Fees \$ 13.65

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Delivery Date Mo. 10 Day 7	Time 12 Noon	Employee Signature [Signature]
<input type="checkbox"/> WAIVER OF SIGNATURE (Domestic Only) Additional merchandise insurance is void if waiver of signature is requested. I wish delivery to be made without obtaining signature of addressee or addressee's agent (If delivery employee judges that article can be left in secure location) and I authorize that delivery employee's signature constitutes valid proof of delivery.		
NO DELIVERY <input type="checkbox"/> Weekend <input type="checkbox"/> Holiday		
Customer Signature		

FROM: (PLEASE PRINT)  
Cathy Ding  
FISH & NEAVE LLP  
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FL C3  
NEW YORK, NY 10020-1104  
PHONE 212.596.9000

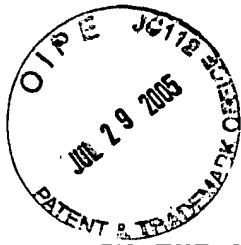
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Commissioner for Patents  
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Alexandria, VA 22313-1450

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Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

REPLY TO OFFICE ACTION

Sir:

Responsive to the July 8, 2004 Office Action,  
applicants respectfully request reconsideration and allowance of  
this application in light of the following remarks.

## REMARKS

### I. Introduction

Claims 1-64 are pending in this application.

Claims 1-14, 16, 18-31, 33, 35-46, 48, 50-61, and 63 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,016,141.

Claims 15, 17, 32, 34, 47, 49, 62, and 64 are objected to as being dependent upon a rejected based claim.

The Examiner's rejections should be withdrawn in view of the following remarks.

### II. The Double Patenting Rejection

Claims 1-14, 16, 18-31, 33, 35-46, 48, 50-61, and 63 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,016,141.

Applicants are submitting herewith a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) to obviate the double patenting rejection. A check in the amount of \$110.00 in payment of the disclaimer fee set forth in 37 C.F.R.

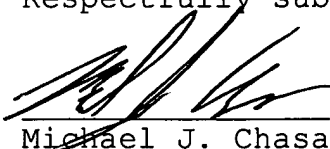
§ 1.20(d) is enclosed. The double patenting rejection should therefore be withdrawn.

Claims 15, 17, 32, 34, 47, 49, 62, and 64 depend from claims 1, 18, 35, and 50 and are objected to as being dependent upon a rejected based claim. The objections to these claims should also be withdrawn in view of the above-mentioned Terminal Disclaimer.

### III. Conclusion

The foregoing demonstrates that claims 1-64 are patentable. This application is therefore in condition for allowance. Reconsideration and allowance are accordingly respectfully requested.

Respectfully submitted,



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicants : Edward B. Knudson et al.  
Application No. : 09/418,461 Confirmation No. : 8923  
Filed : October 15, 1999  
For : INTERACTIVE TELEVISION PROGRAM GUIDE SYSTEM  
WITH PAY PROGRAM PACKAGE PROMOTION  
Group Art Unit : 2611  
Examiner : Christopher R. Nalevanko

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

TERMINAL DISCLAIMER UNDER 37 C.F.R. § 1.321(b, c)

Sir:

United Video Properties, Inc., a corporation of the State of Delaware, having its principal office and place of business at 6922 Hollywood Boulevard, Los Angeles, California 20028, represents that it is the assignee of the entire, right, title and interest in and to the following issued United States Patent and pending United States Patent Application:

1. Knudson et al. United States Patent  
No. 6,016,141, for an "INTERACTIVE TELEVISION PROGRAM GUIDE



SYSTEM WITH PAY PROGRAM PACKAGE PROMOTION," issued January 18, 2000 (the '141 patent). An assignment from the named inventors to TCI-TVGOS, INC. and NEWS AMERICA PUBLICATIONS INC. that is effective for the '141 patent was recorded on September 17, 1998 at Reel 9455, Frames 0195-0202. A Certificate of Amendment of Certificate of Incorporation of NEWS AMERICA PUBLICATIONS INC. that changes the name of NEWS AMERICA PUBLICATIONS INC. to TV Guide Magazine Group, Inc. was filed in the Office of the Secretary of State of the State of Delaware on February 25, 1999 and recorded on July 1, 1999 at Reel 010064, Frames 0925-0927. A confirmatory assignment for the '141 patent from TV Guide Magazine Group, Inc. to TV GUIDE, INC. was executed on June 11, 1999 and recorded on July 1, 1999 at Reel 010064, Frames 0878-0881. A confirmatory assignment for the '141 patent from TCI-TVGOS, INC. to United Video Properties, Inc. was executed on June 16, 1999 and recorded on July 1, 1999 at Reel 010064, Frames 0694-0697. A confirmatory assignment for the '141 patent from TV GUIDE, INC. to United Video Properties, Inc. was executed on June 11, 1999 and recorded on July 1, 1999 at Reel 010064, Frames 0822-0825.

2. Knudson et al. United States Patent Application No. 09/418,461, for an "INTERACTIVE TELEVISION PROGRAM GUIDE SYSTEM WITH PAY PROGRAM PACKAGE PROMOTION," filed October 15, 1999 (the '461 application). An assignment from the named inventors to TCI-TVGOS, INC. and NEWS AMERICA PUBLICATIONS INC. that is effective for the '461 application was recorded on September 17, 1998 at Reel 9455, Frames 0195-0202. A Certificate of Amendment of Certificate of Incorporation of NEWS AMERICA PUBLICATIONS INC. that changes the name of NEWS AMERICA

PUBLICATIONS INC. to TV Guide Magazine Group, Inc. was filed in the Office of the Secretary of State of the State of Delaware on February 25, 1999 and recorded on July 1, 1999 at Reel 010064, Frames 0925-0927. A confirmatory assignment for the '461 application from TV Guide Magazine Group, Inc. to TV GUIDE, INC. was executed on June 11, 1999 and recorded on July 1, 1999 at Reel 010064, Frames 0878-0881. A confirmatory assignment for the '461 application from TCI-TVGOS, INC. to United Video Properties, Inc. was executed on June 16, 1999 and recorded on July 1, 1999 at Reel 010064, Frames 0694-0697. A confirmatory assignment for the '461 application from TV GUIDE, INC. to United Video Properties, Inc. was executed on June 11, 1999 and recorded on July 1, 1999 at Reel 010064, Frames 0822-0825.

The undersigned, on behalf of United Video Properties, Inc., hereby disclaims the terminal portion of the term of any patent to be issued on the '461 application, which would extend beyond the expiration date of the full statutory term of the '141 patent.

The undersigned, on behalf of United Video Properties, Inc., agrees that any patent to be issued on the '461 application shall be enforceable only for and during such period as the legal title to such patent shall be the same as the legal title to the '141 patent, this agreement to run with any patent to be issued on the '461 application and to be binding upon the grantee of such patent and its successors and assigns.

The undersigned, on behalf of United Video Properties, Inc., does not disclaim any terminal part of the term of any patent to be issued on the '461 application, prior to the expiration date of the full statutory term of the '141 patent,

in the event that the '141 patent: (a) expires for failure to pay a maintenance fee, (b) is held unenforceable, (c) is found invalid, (d) is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321(a, b), (e) has all claims canceled by a reexamination certificate, or (f) is otherwise terminated prior to expiration of its statutory term, except for the separation of legal title stated above.

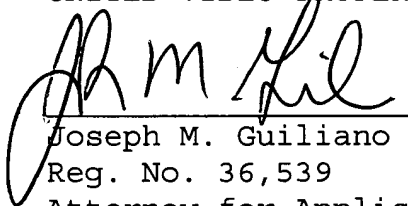
The undersigned hereby states and certifies that:

1. He is an attorney of record in the above-identified patent application, and is authorized to act on behalf of assignee corporation in connection with said application; and

2. The relevant evidentiary documents have been reviewed and, to the best of the undersigned's and assignee's knowledge and belief, title to the above-identified Application No. 09/418,461 is in assignee.

UNITED VIDEO PROPERTIES, INC.

7-19-05  
Date

  
\_\_\_\_\_  
Joseph M. Guiliano  
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